

REMARKS

Claim Amendments

The claims are amended to further clarify them. Claim 10 now explicitly recites that complexing fats and complexing peptides are included. In this regard, applicants point to claims 13 and 30, where a complexing peptide and a complexing fat, respectively, are, and previously were, recited as adhesives. Thus, this clarification to claim 10 does not change its scope.

Additionally, applicants request the entry of new claim 31, where instead of the term “solely” the term “consisting essentially of” is used. This new claim does not present new issues, since it also as the previous claim excludes the prior art adhesive where a peptide in combination with a binder is used.

Rejections Under 35 USC § 112

The Office Action alleges that the specification lacks written description to the adhesive being “solely” a peptide.

Appellants respectfully disagree. While the specification does not use the exact same terminology, it clearly conveys to one of ordinary skill in the art that applicants were, at the relevant time, in possession of the claimed invention. The law is clear that literal support for claim language is not required. See, for example, *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), stating that adequate description under the first paragraph of 35 U.S.C. 112 does not require literal support for the claimed invention, and *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973), stating that it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed.

The specification contains clear description and examples of numerous embodiments where only a peptide is used as a sole adhesive, even though the explicit use of the term “solely” is not used in conjunction with the description. For example, examples 21b, 21c, and 22, all demonstrate the binding of a peptide to a stent without the use of a binder, i.e., these examples all involve the use of peptides as “sole” adhesives. The specification on page 7, for example, describes an embodiment labeled “A.2” where the “uncoated stent is first coated with

the non-activated peptide,” which is then immersed in a solution containing radioactive metal. It is clear here that the coating described in this embodiment is a “peptide” and not a peptide in combination with other adhesive materials.

The Office Action alleges that because the specification appears to teach embodiments where more than one adhesive may be used, that no written description for the claimed matter is present. Whether the specification describes other embodiments not claimed is immaterial, as long as written description to the claimed matter is present, which is the case here. Any given specification may describe multiple distinct embodiments, features of which do not limit each other, in which case reading features of one embodiment into another is improper. This is especially true in the present case, where individual embodiments are even labeled “A.1,” “A.2,” “B.1,” “B.2,” “C.1,” etc.

Furthermore, the Office Action alleges that it is “unclear how the disclosed device would properly adhere ‘solely’ using a peptide,” since Shuthanthiran teaches that for his invention it is “necessary” to combine the adhesive with a binder. This does not question the current invention. Moreover, as discussed above, the specification provides examples 21b, 21c, and 22, which all demonstrate the binding of a peptide to a stent without the use of a binder. Thus, applicants clearly teach by examples, how a peptide can be used without a binder as an adhesive. If Shuthanthiran were relevant, this would provide the evidence the examiner seeks.

Rejections Under 35 USC § 103

The claims are rejected as allegedly obvious over Fischell in view of Shuthanthiran.

The use of adhesives is not taught or suggested by Fischell for fixing radiolabeled isotopes to the surface of the stent, and such is admitted in the Office Action.

Shuthanthiran as discussed above, and as admitted by the Office Action, teaches the use of a peptide for use as an adhesive which adhesive “necessarily” contains a binder. See column 4, lines 15-18. Nevertheless, the Office Action alleges that “it would have been an obvious matter of design choice to a person of ordinary skill in the art to only use a peptide as the adhesive because Applicant has not disclosed that using ‘solely’ a peptide ... provides an advantage ...” Applicants respectfully request that the Examiner explain how can a reference teach that something is “necessary” for the adhesive to work, based on which the Examiner alleges that it is “unclear how the disclosed device

would properly adhere 'solely' using a peptide, fat or gold," yet at the same time make it obvious as a matter of design choice to leave out the binder which was taught to be a "necessary" component from the adhesive?

Nothing in Shuthanthiran teaches or suggests using a peptide as an adhesive without a binder. In order to make a prima facie case of obviousness, the prior art must provide one of ordinary skill in the art with the motivation to make the modifications to the prior art needed to arrive at the claimed invention. See *In re Jones*, 21 USPQ 2d 1941 (Fed. Cir. 1992). That is, the references themselves must provide the motivation for modifications. Instead of motivating toward the claimed invention, Shuthanthiran teaches away by explicitly teaching that using such binder is "necessary." Thus, one of ordinary skill in the art would not have been motivated to remove the binder from the adhesive, as such would be contrary to the teachings of the reference. The teaching away in the prior art reference from the claimed invention is a significant factor to be considered in determining obviousness. See *In re Gurley*, 31 USPQ2d 1130 (CAFC 1994).

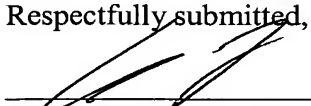
Additionally, whether the references render obvious the claimed invention has nothing to do with applicants' disclosure, including whether advantages over the reference's teachings are disclosed. Applicants' disclosure cannot be used against him/her to provide elements missing in the prior art.

Thus, the rejected claims are not obvious.

Additionally, with respect to claims 13, 29 and 30, nothing in either reference teaches or suggests an adhesive which is a peptide bound to a radioactive isotope complexing agent, gold bound to a thiol-group-containing radioactive isotope complexing agent, or a fat bound to a radioactive isotope complexing agent. Thus, these claims are not obvious for also these additional reasons.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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